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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,718	04/25/2001	Lawrence Clayton	IOM-8233	6284

7590 04/08/2004

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EXAMINER

MILLER, BRIAN E

ART UNIT

PAPER NUMBER

2652

DATE MAILED: 04/08/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/841,718	CLAYTON ET AL.
Examiner	Art Unit	
	Brian E. Miller	2652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 February 2004.
2a) This action is FINAL. 2b) This action is non-final.
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 10-15 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 10-15 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____.

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Claims 11-15 are pending.

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

2. Claims 11-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 11, the language that includes "a stopper of the drive" and further cooperation of the stopper with the "stop feature" is considered indefinite. The preamble sets forth a "cartridge", however, the "stopper" which is part of the drive, is not a part of the cartridge. Therefore, the metes and bounds of the claims are not readily ascertained. Claim 15 further recites details of the stopper which would not encompass the cartridge either.

Claim Rejections - 35 USC § 102

3. Claims 11-13, 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishigami (US 3,893,184). Ishigami discloses a cartridge 3 for being received into a storage drive and retained therein, as shown primarily in FIGs. 1 & 3, including: a shell (unnumbered); a storage media (tape) disposed within the shell as would be readily realized; a stop feature which would include notches 4₁ and 4₂ which would cooperate with a mechanism (stopper) in the drive to stop the ejecting cartridge at a predetermined ejection travel distance (FIG. 3 and col. 3, lines 15-32).

Claim Rejections - 35 USC § 103

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishigami. For a description of Ishigami, see the rejection, supra. While Ishigami is directed to a "tape" cartridge, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized the above retaining configuration in a disc cartridge as well. The motivation would have been: lacking any unobvious or unexpected results, a skilled artisan utilizing the stop feature on a disc cartridge would have realized the same advantages as in a tape cartridge as described by Ishigami, e.g., compact ejection operation employing reduced number of parts (see col. 3, lines 24-32).

Response to Amendment

6. Applicant's arguments filed 2/6/04 have been fully considered but they are not persuasive.

A....Applicant asserts that "Ishigami never teaches or suggests any type of cartridge or system which limits the distance the cartridge is to be ejected. The claims require the stop feature be adapted to interface with a stopper to control the ejection distance of the cartridge."

This is considered unpersuasive by the Examiner, as the claim merely sets forth "a stop feature on a surface of the shell, the stop feature adapted for being contacted by the stopper." It is

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maintained that Ishigami teaches a stop feature, which would include notches 4₁ and 4₂ that would be adapted to cooperate with a mechanism (stopper) in the drive to stop the ejecting cartridge at a predetermined ejection travel distance, as required by the claim(s). The stopper is still not considered as encompassed by the metes and bounds of the claim, as previously set forth in the rejection under 35 U.S.C. § 112 paragraph 2. The remainder of the claim is considered to include “intended use” recitations, such that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claim apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987). Thus, the rejection(s) have been maintained.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Miller whose telephone number is (703) 308-2850. The examiner can normally be reached on M-TH 7:15am-4:45pm (and every other friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brian E. Miller
Primary Examiner
Art Unit 2652

Bem
4/6/04